

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

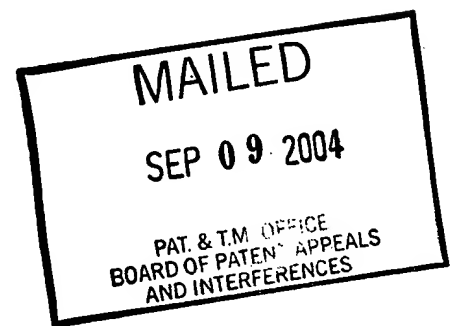
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC ROBINSON

Appeal No. 2003-0744
Application No. 09/416,675

ON BRIEF



Before THOMAS, RUGGIERO, and LEVY, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 21-40, which are all of the claims pending in the present application. Claims 1-20 have been canceled. An amendment filed March 12, 2002 after final rejection was denied entry by the Examiner.

The disclosed invention relates to the automatic backup of data on a computer in which an automatic backup system (ABS) unit is connected to a PCMCIA port on the computer. The CPU of the

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computer, upon scanning the PCMCIA port and recognizing the inserted ABS unit, automatically launches the automatic backup procedure without operator intervention.

Claim 21 is illustrative of the invention and reads as follows:

21. A method of automatically backing up data from a computer comprising:

connecting an ABS unit designated as a data backup to a PCMCIA port on a computer;

the computer scanning for devices connected to its PCMCIA port;

the computer recognizing the ABS unit inserted into its PCMCIA port;

the computer launching its automatic backup procedure;

the computer scanning all files on its source drives and comparing the files on the ABS unit for date and time changes to identify file changes;

the computer comparing space available on the ABS unit and comparing it to the space required to back up file changes on the source drive in the computer; and

the computer making a file-by-file transfer of the file changes on the source drive to the ABS unit, if the computer finds enough space available on the ABS unit for the file changes.

The Examiner relies on the following prior art:

Makinen et al. (Makinen)	5,758,067	May 26, 1998
Harari et al. (Harari)	5,887,145	Mar. 23, 1999

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Claims 21-40, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Makinen in view of Harari.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and the Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims

¹ The Appeal Brief was filed October 8, 2002 (Paper No. 20). In response to the Examiner's Answer mailed December 17, 2002 (Paper No. 21), a Reply Brief was filed April 22, 2003 (Paper No. 24), which was acknowledged and entered by the Examiner in the communication dated July 29, 2003 (Paper No. 29).

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21-27 and 31-40. We reach the opposite conclusion with respect to claims 28-30. Accordingly, we affirm-in-part.

With respect to each of the appealed independent claims 21 and 40, Appellant asserts that the Examiner has not established a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After reviewing the disclosure of the applied Makinen and Harari references in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated at pages 4, 8, 9, 14, and 15 of the Answer.

Initially, Appellant contends (Brief, pages 7, 12, 13, 26 and 27) that, in contrast to the claimed invention in which a backup procedure is automatically launched when an ABS unit is inserted into the PCMCIA port of a computer, Makinen requires the use of a scheduler in which backup is launched according to specific scheduled dates and times. We do not necessarily disagree with Appellant that the system disclosed by Makinen does not operate in the same manner as that disclosed by Appellant. It is the claimed invention, however, which is before us on appeal. With this in mind, our review of the specifics of

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appealed claims 21 and 40 reveals that, as also asserted by the Examiner, no claim language exists which precludes the use of a scheduler.

We recognize that Appellant, in the Reply Brief (pages 2, 3, and 6), has addressed the Examiner's assertion that the claims do not exclude the use of a scheduler to launch a backup procedure. In particular, Appellant asserts that the sequence of steps appearing in claims 21 and 40 excludes a scheduler since the claims set forth that a backup procedure is automatically launched upon recognition that an ABS unit is inserted into a PCMCIA port. It is apparent from our reading of the claim language, however, that, although the claimed steps are listed in a particular order, we find no claimed requirement that the steps be performed in this listed sequence or in any particular sequence. In particular, we find, Appellant's arguments to the contrary notwithstanding, no claimed requirement that the backup procedure launching step be performed, after, or upon, or in response to the ABS unit recognizing step. In our view, Appellant's arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Turning to a consideration of Appellant's arguments directed to the alleged lack of motivation for the Examiner's proposed combination of Makinen with Harari, we find no error in the Examiner's position as articulated at pages 4, 8, 9, 14, and 15 of the Answer. In our view, Appellant's arguments unpersuasively focus on the individual differences between the limitations of claims 21 and 40 and each of the applied references. It is apparent, however, from the Examiner's line of reasoning in the Answer, that the basis for the obviousness rejection is the combination of Makinen and Harari. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

In other words, while Appellant contends (Brief, pages 12, 13, 27, and 28; Reply Brief, pages 3-6) that Harari lacks a teaching of the particulars of an automatic backup procedure, these features as claimed are provided by Makinen. We also find, contrary to Appellant's contention, clear motivation for the skilled artisan to combine Harari's teaching of a memory card connected to a computer's PCMCIA port with the automatic backup

teachings of Makinen since Harari specifically suggests (column 9, lines 18-30) that the disclosed removable memory card arrangement can be used for automatic backup purposes.

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 21 and 40 is sustained.

We also sustain the Examiner's rejection of dependent claims 22-25 since it is our opinion that the skilled artisan would have recognized and appreciated that the disclosure of Makinen teaches and suggests the features set forth in these claims. For example, the status including termination of the backup procedure in Makinen is provided to the backup system since the disk backup percentage is indicated, the backup tape is rewound after termination, and the incremental backup procedure would clearly function relative to which files have been changed since the last update. (Makinen, column 3, line 39 through column 4, line 32).

Similarly, the rejection of dependent claims 26 and 27, directed to a manual backup launch option, is also sustained. In our view, the skilled artisan would have recognized from the disclosure of Makinen that a user could start the backup

procedure manually by merely entering the current time in the user interface screen illustrated in Figure 5 of Makinen.

Further, it is apparent that Makinen contemplates (column 4, lines 24-33) manual control of the backup procedure since a user option to cancel the automatic procedure is provided.

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 31-39 based on the combination of Makinen and Harari. Claim 31 has not been separately argued by Appellant and the extent of Appellant's arguments (Brief, pages 21-26) with respect to claims 32-39 is to repeat the language of the claims and the Examiner's statement of the rejection followed with a general allegation that the references do not teach or suggest the claimed imitations. Simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not comply with 37 CFR § 1.192(c)(8) and does not amount to a separate argument for patentability. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Further, our review of the Examiner's position (Answer, pages 6, 7, and 12-14) reveals no error in the Examiner's assertion of obviousness with respect to the features set forth in claims 31-39.

We next consider the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 28-30 and note that, while we found Appellant's arguments to be unpersuasive with respect to the Examiner's rejection of claims 1-27 and 31-40 discussed supra, we reach the opposite conclusion with respect to claims 28-30. Our review of the language of dependent claim 28 reveals that, unlike the broadly stated limitations of independent claims 21 and 40, claim 28 requires a specific sequence of operations related to the launch of the automatic backup procedure. As set forth in claim 28, the computer scans its registry for an automatic backup launch file "when the computer recognizes the ABS unit connected to its PCMCIA port."

Although the Examiner has recognized that Makinen in combination with Harari lacks a disclosure of such a feature (Answer, page 5), the Examiner nevertheless suggests the obviousness to the skilled artisan of providing such a scan feature for the purpose of avoiding the need for operator intervention. We find, however, no evidence on the record before us that would support such a contention. In our view, the only suggestion to provide such a feature in the system of Makinen as modified by Harari comes from Appellant's own disclosure and not from any teaching in the references themselves.

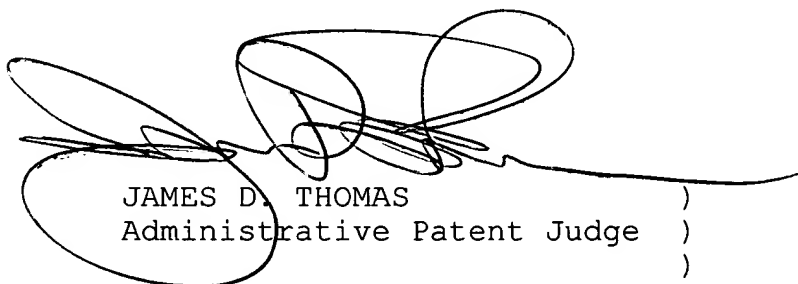
Similarly, we find no evidence to support the Examiner's position with respect to the password features of dependent claims 29 and 30. As acknowledged by Appellant, the use of passwords for entry into computer systems is well known; however, the limitations of dependent claims 29 and 30 require a specific combination of password requests, the operation of password translation from the computer to the ABS unit, and the automatic launch of the backup procedure in response to password verification. It is well settled that "the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006-07 (Fed. Cir. 2002).

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In summary, with respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 21-40, we have sustained the rejection of claims 1-27, and 31-40, but have not sustained the rejection of claims 28-30. Therefore, the Examiner's decision rejecting claims 21-40 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

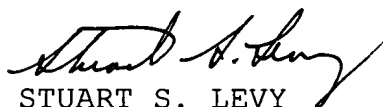
AFFIRMED-IN-PART



JAMES D. THOMAS
Administrative Patent Judge



JOSEPH F. RUGGIERO
Administrative Patent Judge



STUART S. LEVY
Administrative Patent Judge

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